

REMARKS:

In the foregoing amendments, editorial amendments were made to claims 1 and 2 so as to better define applicant's invention. Claims 3 and 4 were canceled. Claims 5-9 were added to the application. The foregoing amendments were made to clarify what was already implied in applicant's claims and these amendments are not narrowing amendments and were not made for reasons substantially related to patentability presented. Claims 1, 2 and 5-9 are pending in the application for consideration by the examiner.

Applicant desires to express thanks to Examiner Spisich for the courtesies extended the undersigned in a personal interview on November 8, 2006. During this interview, the rejection under 35 U.S.C. §103(a) and proposed amendments to the claims were discussed, but no agreement was reached. The proposed amendments to the claims that were discussed at the interview are similar to those set forth in the foregoing amendments.

Claims 1 and 2 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 6,098,739 of Anderson *et al.* (Anderson). This rejection appears on pages 2-4 of the Official action. Applicant respectfully submits that the teachings of Anderson do not disclose or suggest the inventions set forth in claims 1, 2 and 5 -9 within the meaning of 35 U.S.C. §103(a) for at least the following reasons.

Namely, the invention defined in the present claims includes, *inter alia*, a main frame of a construction machine, the main frame including unitary casting modules made by metal casting and a sheeted module made by a process including welding, the unitary casting modules and the sheeted modules being joined together to form the main frame. The device proposed by

Anderson includes metallic materials that are welded together. See, for example, the discussion in Anderson at column 4, line 19, through column 5, line 24, and elsewhere. Accordingly, the frame proposed by Anderson at best corresponds to a sheeted module, as described in the present application. Since the teachings of Anderson do not have any disclosure therein concerning unitary casting modules made by metal casting, as required in the present claims, applicant respectfully submits that the teachings of Anderson are not particularly pertinent to the presently claimed invention, and thus, the claimed invention is patently distinguishable from the teachings of Anderson.

The Official Action took the position that whether or not the modules are formed from a unitary casting or a sheeted module is not germane to the issue of patentability of the device itself, and for this reason, stated that these alleged method limitations were not given any patentable weight. A similar position appeared in the Interview Summary, which was given to the undersigned at the time of the personal interview, where it is stated that the applicant was informed that methods of forming the apparatus are given little patentable weight in apparatus claims. Applicant respectfully submits that method limitations must be given patentable weight or patentability consideration in apparatus claims in a manner that at least must be decided on a case-by-case basis. A fixed or inflexible position of not giving any or little consideration to method limitations in apparatus claims appears to be an attempt to illicit a *per se* rule of claim construction and obviousness that is prohibited by U.S. patent law. The Court of Appeals for the Federal Circuit explicitly stated in *In re Ochiai*, 37 USPQ2d 1127, 1131 (1995), that there are no such *per se* rules of nonobviousness. This case required that to determine whether an invention

would have been novel or obvious in light of the prior art requires one to compare the claimed “subject matter as a whole”. 37 USPQ2d at 1131.

The U.S. Supreme Court and the Court of Appeals for the Federal Circuit have repeatedly held that each and every limitation in the applicant's claims must be considered when determining patentability. See, e.g., *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908) ("[T]he claims measure the invention."); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 4 USPQ2d 1737 (Fed. Cir. 1987) (*in banc*), *cert. denied*, 485 U.S. 961, *cert. denied*, 485 U.S. 1009 (1988); *Perkin-Elmer Corp. v. Westinghouse Elec.*, 3 USPQ2d 1321 (Fed. Cir. 1987); *Lemelson v. United States*, 224 USPQ 526, 533 (Fed. Cir. 1985). As explained in *Ochiai*, the obviousness inquiry is highly fact-specific and not susceptible to *per se* rules.

People skilled in the art of applicant's claimed invention understand that a unitary casting module made by metal casting has a structure different than a sheeted module made by a process including welding. A unitary casting module made by metal casting has no seams or welds, while a sheeted module made by a process including welding necessarily has seams or welds. A unitary casting module made by metal casting is a single undivided, whole piece of material, normally having a homogeneous composition; whereas a sheeted module made by a process including welding is a combination of a plurality of different pieces of material that are welded together. The present inventors have discovered that combining a unitary casting module made by metal casting with a sheeted module made by a process including welding provides a novel and unobvious main frame that has properties superior to a main frame made completely from sheeted modules, such as allegedly proposed by Anderson. In particular, the applicant has discovered that the structure of a unitary casting module made by casting is superior for the

portions of the main frame that are subjected to external forces, such as for the attachment of traveling units or a working machine (i.e., hydraulic cylinder 5 and ripper 6, such as shown in figure 1 of the present application). Applicant's claims 5-8 define that the points of application of an external force on the mainframe are arranged within the unitary casting modules. A reason for this is that the unitary casting module is stronger than a corresponding sheeted module. When a traveling unit or a working machine is attached to a sheeted module, points of stress occur in each of the welded portions of the sheeted module due to the external force. This reduces the durability of main frames structures that have traveling units or a working machine attached to a sheeted module, because the welds within the sheeted module can fail over time due to the external force. Applicant's claimed invention by attaching a traveling unit or working machine only to the unitary casting modules provides a main frame that is superior in durability to a corresponding mainframe where a traveling unit or working machine is attached to a sheeted module. This arrangement is an important structural difference between the inventions defined in applicant's claims and the structures in the prior art such as that proposed, for example, by Anderson.

The MPEP at § 2113 explains the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or *where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product*. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place,"

"press fitted," and "etched" are capable of construction as structural limitations.) The limitations in the present claims including "unitary casting module made by metal casting" and "sheeted module made by a process including welding" are the same type of limitations discussed in *Garnero* (i.e., "welded"), and thus, must be considered when determining the patentability of applicant's claimed invention.

The structural differences between "unitary casting module made by metal casting" and "sheeted module made by a process including welding," as discussed above, are understood by those skilled in the art and impart structural limitations and resulting properties to applicant's claims not contemplated or suggested by the teachings of Anderson. In other words, in the environment of applicant's claimed invention, the unitary casting module provides structural advantages over the sheeted module, thereby imparting properties to the inventions in applicant's claims that are not present in main frames formed from only welding sheeted metals together, such as proposed by Anderson. Therefore, the presently claimed invention is patently distinguishable from the teachings of Anderson.

Applicant's claim 2 and 9 define the structure of a construction machine according to claim 1 or a combination of parts for a main frame of a construction machine, comprising, *inter alia*:

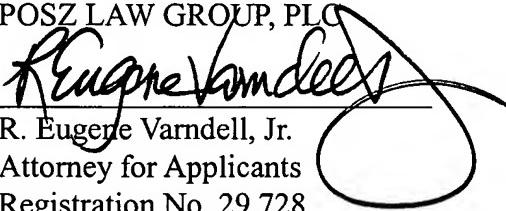
a plurality of the unitary casting modules made by metal casting;
a plurality of sheeted modules made by a process including welding; and
members of the plurality of the unitary casting modules and the plurality of sheeted modules being subsequently joined together to form a main frame of the construction machine.

Since the teachings of Anderson do not contemplate or suggest unitary casting modules, such teachings cannot remotely contemplate or suggest the inventions defined in present claims 2 and 9.

In accordance with the foregoing amendments and remarks, applicant respectfully submits that the presently claimed invention is patently distinguishable from the teachings of Anderson within the meaning of 35 U.S.C. §103. Therefore, applicant respectfully requests that the examiner reconsider and withdraw the rejection of claims 1 and 2 over Anderson as set forth in the outstanding Office action.

Based on the above, a formal allowance of claims 1, 2 and 5-9 is respectfully requested. The foregoing is believed to be a complete and proper response to the Official action mailed August 22, 2006. While it is believed that all the claims in this application are in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which become due, may be charged to our deposit account No. 50-1147.

Respectfully submitted,
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